

JAN 23 2006

211A 3160 PCT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

MINORU TAKEBE

Serial No.: 10/070,889

Filed: March 6, 2002

For: ANTI-OBESITY MATERIAL

Art Unit: 1617

Examiner: Jennifer M. Kim

REQUEST FOR REFUND

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Mail Stop 16
Director of the USPTO
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Upon review of the Monthly Statement of Deposit Account dated December 30, 2004 (copy enclosed), an error was found. In particular, on July 14, 2004, Applicant filed an Amendment via facsimile on the above-identified application in response to the Office Action dated January 14, 2004, together with a request that the U.S. Patent Office charge Deposit Account No. 11-1445 in the amount of \$950.00 for a three-month extension of time. However, a charge of \$980.00 instead of \$950.00 was erroneously assessed to the account of the undersigned. Since Applicant filed a response on July 14, 2004, before the Patent Office fees went up October 1, 2004, Applicant respectfully requests a refund in the amount of \$30.00 as a credit to KODA & ANDROLIA DEPOSIT ACCOUNT NO. 11-1445. Copies of facsimile transmitted Amendment dated July 14, 2004 is attached for your records including communication result report which indicates successful transmission of the Amendment.

Respectfully submitted,

KODA & ANDROLIA

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OIPE/IAP

JAN 30 2006

By

William L. Androlia
Reg. No. 27,177

2029 Century Park East
Suite 1140
Los Angeles, CA 90067-2983
Tel: (310) 277-1391
Fax: (310) 277-4118

Certificate of Transmission:

I hereby certify that this correspondence is being facsimile transmitted to the Patent and Trademark Office Fax No. (571) 272-8500 on January 23, 2006.

William L. Androlia

Name

Signature

1/23/2006

Date

01/23/2006 11:10 3102774118

KODA ANDROLIA

PAGE 03/08

P. 1

* * * COMMUNICATION RESULT REPORT (JUL. 14. 2004 . 3:24PM) * * *

FAX HEADER: KODA & ANDROLIA

TRANSMITTED/STORED : JUL. 14. 2004 3:21PM
FILE MODE OPTION

892 MEMORY TX

ADDRESS

US PATENT OFFICE

RESULT

OK

PAGE

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REASON FOR ERROR
E-1) NO ANSWER LINE FAIL

E-2) BUOY FACSIMILE CONNECTION

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Examiner: Jennifer M. Kim

AMENDMENT

Commissioner for Patents
P.O. Box 1450
Alexandria VA 22313-1450

Dear Sir:

In response to the Office Action dated January 14, 2004, it is respectfully requested that the Examiner consider the following remarks and reconsider the rejection.

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AMENDMENT

Commissioner for Patents
P.O. Box 1450
Alexandria VA 22313-1450

Dear Sir:

In response to the Office Action dated January 14, 2004, it is respectfully requested that the Examiner consider the following remarks and reconsider the rejection.

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REMARKS

The Examiner has rejected claims 1-7 under 35 USC 102 as being anticipated by Takebe et al., namely USP 5,885,632.

Applicant respectfully submits that this rejection is incorrect. In particular, Applicant respectfully submits that Takebe et al. has the same common owner as the present application, has different inventorship (joint inventors consisting of three inventors in which one is in common with the present application), and is an issued patent which is in conflict with the present application. In addition, Applicant respectfully submits that the claimed invention of Takebe et al. is different from the claimed invention of Applicant's application. In particular, claims 1-7 of Takebe et al. are all essentially a process. In particular, claims 1-6 are a process and claim 7 is a product-by-process in which the invention is defined by the process steps. In contrast thereto, Applicant's invention as claimed by claims 1-7 are all a product. Since this is conflict between an application and a patent having different inventions, different inventorship and which was commonly owned at the time the application was filed, Applicant respectfully submits that pursuant to MPEP Section 804, the proper rejection would have been an obviousness double patenting rejection. Since the proper rejection should have been an obviousness double patenting rejection, Applicant respectfully submits that such a rejection can be overcome by filing of a terminal disclaimer. Therefore, filed together with this response is a terminal disclaimer. As a result, Applicant respectfully requests that the Examiner withdraw the rejection under 35 USC 102, anticipation, enter the terminal disclaimer and pass this case to issue.

Applicant further respectfully and retroactively requests a three month extension of time so as to respond to the Office Action. Please charge Deposit Account No. 11-1445 in the sum of \$950.00 as the fee.

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TERMINAL DISCLAIMER

Commissioner for Patents
P.O. Box 1450
Alexandria VA 22313-1450

Dear Sir:

The owner, Nichimo Co., Ltd., of 100 percent interest in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. 154 and 173, as presently shortened by any terminal disclaimer, of prior Patent No. 5,885,632. The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and the prior patent are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

In making the above disclaimer, the owner does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. 154 and 173 of the prior patent, as presently shortened by any terminal disclaimer, in the event that it later: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 C.F.R. 1.321, has all claims canceled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer.

1. ☐ For submissions on behalf of an organization (e.g., corporation, partnership,

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university, government agency, etc.), the undersigned is empowered to act on behalf of the organization.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

2. ☒ The undersigned is an attorney of record.
3. ☒ Please charge Deposit Account 11-1445 in the amount of \$110.00 to cover the Terminal disclaimer fee under 37 C.F.R. 1.20(d).

Date: 7/14/04By: 

William L. Androlia
Reg. No. 27,177

2029 Century Park East
Suite 1430
Los Angeles, CA 90067
Tel: (310) 277-1391
Fax: (310) 277-4118

Certificate of Transmission

I hereby certify that this correspondence is being facsimile transmitted to the Patent and Trademark Office Fax No. (703) 872-9306 on July 14, 2004.

William L. Androlia

Name


Signature7/14/2004

Date

#7/B
11/24/03
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AMENDMENT

Commissioner for Patents
P.O. Box 1450
Alexandria VA 22313-1450

Dear Sir:

It is respectfully requested that an Amendment be entered as follows:

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03/17/2006 EEKUBAY1 00000002.111445 10070889

01 FC:1253 950.00 DA

12/20/2004 MMAY22 00000001.111445 10070889

01 FC:1253 960.00 DA

Adjustment date: 03/17/2006 EEKUBAY1
12/20/2004 MMAY22 00000001.111445 10070889
01 FC:1253 980.00 CR

08/30/03 TUE 19:05 (TX/RX NO 5291) 0001